

Notice of Allowability

Application No.

10/822,888

Examiner

Robert Sellers

Applicant(s)

NAKAYOSHI ET AL.

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed December 14, 2005.
2. ☒ The allowed claim(s) is/are 1,3 and 7-15.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 1205.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

1. The election with traverse of the species in the reply filed on December 14, 2005 is acknowledged. The traversal is on the grounds that there is no statement that the inventions are independent or distinct, and there is no establishment of a serious burden. This is not found persuasive because MPEP § 808.01(a) permits an election of species when "the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claimed." Each of the claimed components (A) to (F) encompass such a multiplicity of species as evidenced by newly submitted claims 3-14.

The requirement is still deemed proper and is therefore made FINAL.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Catherine Brown on December 27, 2005.

The application has been amended as follows:

Reinstate withdrawn claim 3.

Claim 7, line 10, delete "or".

Claim 11, lines 2 and 6, and claim 14, lines 1 and 3, after "selected from" insert --the group consisting of--.

Claim 11, lines 5 and 10, and claim 14, lines 2 and 4, replace "or" with --and--.

Claim 11, line 2, delete "and".

The following is an examiner's statement of reasons for allowance:

3. The non-Final rejection mailed September 2, 2005 assumed the election of the species of silver flake treated with a dimethylvinylsiloxyl-endblocked dimethylpolysiloxane for component (C) (page 4, lines 1-2) as in parent application no. 10/052,760. However, the amendment filed December 14, 2005 indicates the election of silver flake treated by a silanol-endblocked dimethylsiloxane oligomer (page 10, lines 6-7) as supported by page 6, lines 11-13 and claim 3. Therefore, the election in the amendment overrides the assumed election in the non-Final rejection.
4. The obviousness-type double patenting rejection over U.S. Patent No. 6,797,772 is based on the claiming of silver particles pre-treated with particular species of alkoxysilanes or organosiloxanes which are not silanol endblocked.
5. Each of the other rejections set forth on pages 5-12 of the non-Final rejection relies upon Fukui et al. Patent No. 4,801,445 and Japanese Patent No. 1-249880 to teach the treatment of silver particles with a polycyclodimethylsiloxane or trimethylsiloxyl endblocked polymethylhydrogensiloxane (Fukui et al.), or a silane coupling agent such as 3-glycidopropyltrimethoxysilane or an alkoxysilane (Japanese patent).
6. None of the cited prior art recites the claimed silver particles (C) newly limited to a pre-treatment with a silanol endblocked siloxane oligomer. A further search of this particular species was not unearthed.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712

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12/27/2005